



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/836,686	04/17/2001	Mark T. Gross	INTL-0556-US (P11214)	7180

7590 12/20/2004

Timothy N. Trop  
TROP, PRUNER & HU, P.C.  
8554 KATY FWY, STE 100  
HOUSTON, TX 77024-1805

EXAMINER
----------

FLETCHER, MARLON T

ART UNIT	PAPER NUMBER
----------	--------------

2837

DATE MAILED: 12/20/2004

15

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/836,686

Applicant(s)

GROSS, MARK T.

Examiner

Marlon T Fletcher

Art Unit

2837

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 26 August 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 10-17 and 21-25 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 17, 21 and 22 is/are allowed.
- 6) ☒ Claim(s) 10-16 and 23-25 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

Art Unit: 2837

1. In view of the Decision on Appeal filed on August 26, 2004, PROSECUTION IS HEREBY REOPENED with regards to claim 25. Claim 25 is rejected on new grounds as set forth below. Claims 10-16 and 23-24 are rejected. Based on the Decision on Appeal, the examiner was affirmed and these claims should be cancelled. Claims 17, 21, and 22 are allowed.

To avoid abandonment of the application, appellant must exercise one of the following two options:

- (1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,
- (2) request reinstatement of the appeal.

If reinstatement of the appeal is requested, such request must be accompanied by a supplemental appeal brief, but no new amendments, affidavits (37 CFR 1.130, 1.131 or 1.132) or other evidence are permitted. See 37 CFR 1.193(b)(2).

### ***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claim 25 is rejected under 35 U.S.C. 103(a) as being unpatentable over Abecassis (6,192,340) in view of Bertis et al. (6,282,653) and applicant's admission.

Abecassis discloses a portable device (100, 200), comprising: an interface (106)

Art Unit: 2837

to receive at least one file from another device as discussed in column 7, lines 23-42; and a controller (131) to be communicatively coupled to the interface, the controller to allow transfer of the file as discussed in column 7, lines 43-54.

Abecassis discloses a method, comprising: selecting at least one music file from a first portable device to transfer to a second portable device as discussed in column 10, lines 50-64; transferring the music file to the second portable device as discussed in column 5, lines 40-48; and wherein the portable device may transfer the music file to one or more devices.

Abecassis does not disclose the use of a transfer count nor encryption of a file.

However, Bertis et al. disclose a transfer count which can be embedded in a file to control and update a system based on the number of transferred files as discussed in the abstract and column 8, line 56 through column 9, line 17.

Bertis et al. disclose encrypt or secure files as discussed in column 7, lines 47-49.

Neither Abecassis nor Bertis et al. teach the use of a SDMI player.

However, the applicant admits that the SDMI standard and SDMI players are known in the art as discussed on page 1, lines 17-21 of the specification.

It would have been obvious to one of ordinary skill in the art at the time of the invention to utilize the teachings of Bertis et al. with the apparatus of Abecassis, because the teachings provide enhancement by allowing the apparatus to count the transfer files and provide control over the transferring of files to other devices. Further Bertis et al. teaches file security. Based on applicant's admission, it would have been

Art Unit: 2837

obvious to one of ordinary skill in the art to provide the devices with SDMI or thereby, using SDMI players to provide a secure file system amongst the devices.

***Allowable Subject Matter***

4. Claims 17, 21, and 22 are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marlon T Fletcher whose telephone number is 571-272-2063. The examiner can normally be reached on M-W, F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Martin can be reached on 571-272-2107. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

12/17/04  
*mtf*

*[Signature]*  
RICHARD K. SEIDEL  
DIRECTOR  
TECHNOLOGY CENTER 2800

*[Signature]*  
Marlon T Fletcher  
Primary Examiner  
Art Unit 2837